

Remarks

Claims 1-9 and 11-20 are pending. Claims 1-9 and 11-20 stand rejected under Section 102 as being anticipated by Kageyama (6333790) or under Section 103 as being obvious over Kageyama in view of Lee (6628413).

Claim 1 recites a hard copy device that includes a memory unit containing an electronic document file which is retrieved, on command, from said memory by the device processor and printed in hardcopy form. The Office argues these limitations are met in Kageyama because the information file from Kageyama Fig. 10:

"**can be** printed out using printer engine 220, please see col. 6, lines 53-60. Inherently, any data stored in printer's memory are printable by printer engine 2200." Office Action, page 5 (emphasis added).

This statement is insufficient to support the rejection for two reasons. First, it is not factually accurate. Print engine status information such as that shown in Fig. 10 of Kageyama is typically not printable. If the Office disagrees, it is respectfully requested to support its finding with citation to some credible authority. Second, and more importantly, Kageyama does not teach printing the Fig. 10 information file, either explicitly or inherently. Kageyama explicitly teaches only that the Fig. 10 information file is transmitted electronically to a computer. Kageyama column 10, lines 28-42 and column 12, lines 46-55.

To establish inherency, the Office must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV. Even if it is assumed, therefore, that Kageyama's information file "can be" printed, this fact alone does not in any way establish that the information file is necessarily printed. Indeed, the more reasonable conclusion from the teachings of Kageyama is that the information file is not printed.

The Office has failed to establish a prima facie case of anticipation with regard to Claim 1 and the rejection of Claim 1 should be withdrawn. Claims 13 and

20 contain similar limitations and, for these same reasons therefore, the rejection of Claim 13 and 20 should also be withdrawn.

Further with regard to Claim 4, which recites a menu from which a command to print the electronic document file is selected, the control panel in Fig. 6 of Kageyama does not show any such menu, nor is any such menu described in the text in Kageyama.

Further with regard to Claim 5, which recites a display that advertises a specific manipulation to issue a command to print the electronic document file, Fig. 10 in Kageyama shows the contents of an information file not any kind of a display or advertisement of a print command.

Further with regard to Claim 6, which recites a connection to a host device through which the host device issues a command to print the electronic document file, there is no indication that any of the computers 1 or 2 in Fig. 1 of Kageyama issues a command to the printer 200 to print the information file of Fig. 10.

Further with regard to Claim 7, which recites a connection to a host device through which an updated electronic document file is downloaded from the host device to the hard copy device, the program and data updates discussed at columns 14-15 of Kageyama appear to be unrelated to the information file shown in Fig. 10 (which the Office asserts is the electronic document file recited in the base claim). Kageyama, therefore, cannot reasonably be deemed to teach the further limitations of Claim 7.

Claims 14-17 recite limitations similar to those recited in Claims 4-7. For these same additional reasons, therefore, Claims 14-17 also distinguish over Kageyama.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,



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RESPONSE TO OFFICE ACTION -6-

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